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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/713,545 | 11/13/2003 | William Lawrence Whitaker | 02-626-US | 7960 |

7590

12/19/2005

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EXAMINER

LEE, JONG SUK

ART UNIT

PAPER NUMBER

3673

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------------------------------|-----------------------------------------|--|
| Office Action Summary | Application No. 10/713,545 | Applicant(s) WHITTAKER ET AL. | |
| | Examiner Jong-Suk (James) Lee | Art Unit 3673 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9-16,18 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16,18 and 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. The amendment filed December 1, 2005 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-16, 18 and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holland (US 6,887,014) in view of Ross et al (US 2004/0055746).

Holland discloses a robotic apparatus and method for treatment conduit comprising a lateral device housing; an anchor device to secure said housing to an inner wall of one of a plurality of lateral pipes (2), the lateral pipe which intersects with a main pipe (1), wherein the lateral device being anchored in the lateral pipe, a work tool (13) being powered from onboard said lateral device (10), wherein the work tool may be a rotary bit cutting tool in which a rotating arm supporting said rotary bit cutting tool is spring biased against the inner wall of the against pipe, or a hole saw cutting tool, or a grinding device including spring tensioning that automatically adjusts a cutting diameter of the grinding device to the size of the inside wall of

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the lateral pipe, or an electrically generated signal source, wherein said work tool is an attachment adapted to drag a liner up into said lateral pipe from the main pipe, a state of said work tool is determined based on local decision-making from on board the lateral device (col.12, lines 25-43), the power supply (3) being connected remotely via umbilical (5b). (see Figs. 1-25; col.5, lines 20-68; col.6, lines 1-43).

However, Holland fails to disclose or fairly suggest the local power supply onboard the lateral device to provide power to the work tool.

Ross et al discloses a subterranean well completion incorporation downhole-parkable robot (26) including an onboard rechargeable battery (30) (see Figs. 1-2; paragraph no. [0034]-[0038]).

Therefore, in view of Rose et al, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to replace the power supply with the onboard rechargeable battery in order to enhance the movability of the lateral device within the lateral pipe and avoid the umbilical's entanglement while in moving to the lateral pipes.

Response to Arguments

5. Applicant's arguments with respect to the Holland reference that a tethered robot performs work being guided from the surface using power and the combination with the Ross reference that only moves longitudinally within a single axis tubular structure without being loaded or unloaded into/from a lateral are not persuasive because in apparatus claims 9 and 23, claimed structural elements are merely recited such as a lateral device housing, an anchor device,

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a work tool being powered onboard the lateral device with a local power supply without mentioning “untethered” device from the surface control in the body of the claim.

Rather, the rechargeable battery of the Ross reference is understood to be “the local power supply” as it is onboard and these two reference can be meant to be viewed together by adding the local power supply to the Holland’s lateral device for the back-up power in case of power shortage from the surface control and not meant to be viewed individually insofar as there is no claiming structural relationships for the independency of the lateral device from the surface control.

Applicant argument to method claim 1 is persuasive and the art rejection is hereby withdrawn.

Allowable Subject Matter

6. Claim 1 would be allowable over the prior art or record.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (571) 272-7044. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
December 13, 2005



Jong-Suk (James) Lee
Primary Examiner
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